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FILED

OCT 18 1945

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IN THE
SUPREME COURT OF THE UNITED STATES

October Term, 1945

NO. 330

JAMES W. WABER,

Petitioner,

vs.

MONTGOMERY WARD & CO.
INCORPORATED, AND
UNITED STATES RUBBER
COMPANY,

Respondents.

On Petition for Writ of
Certiorari to the United
States Circuit Court of
Appeals for the Seventh
Circuit.

PETITION FOR REHEARING

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James W. Waber respectfully requests the Court to rehear his petition for the writ of certiorari, filed on August 17, 1945, and denied by the Court on October 8, 1945. This petition for rehearing is filed within the 25 day period provided by Rule 33, Rules of this Court.

The petition for the writ of certiorari urged principally that the Circuit Court of Appeals was not justified in striking down letters patent upon the negative test that

“a person trained and skilled in the making of tubes, by studying and understanding this prior art, could have duplicated the accomplishment of Waber” (R. 470).

The petitioner sincerely believes that the “could have duplicated” test of invention should be stricken from the

books and has made further search of the authorities with respect to this unsound and unauthorized test. It is now observed that the test is in direct conflict with a prior holding of this Court on the identical issue, and that the opinion of the Circuit Court of Appeals is therefore untenable.

The "could have duplicated" test was seriously debated in *The Telephone Cases* (1888) 126 U. S. 1. That this Court carefully considered the issues is manifest. The argument continued for twelve days; the Court required 147 pages to discuss the facts (126 U. S. 3-149); the arguments of counsel are reported at length (126 U. S. 149-531); and the 43 page opinion analyzes each of the points raised in argument (126 U. S. 531-573).

The defendants urged that the Bell telephone patents were invalid in view of the prior invention of Philipp Reis, among others. The Reis apparatus could be made to perform exactly like that of Bell either (as defendants asserted) by merely adjusting a set-screw and springs with which the apparatus was provided (126 U. S. 192) or (as plaintiff admitted) by making a slight physical change in the mechanism (126 U. S. 289).

The defendants argued that the Reis method "*will necessarily become familiar to any skilled person studying the operation of that apparatus*" and that the Reis current "*was capable of being made similar*" to that of Bell (126 U. S. 152). It was also urged that the apparatus of one of the defendants was "*precisely that method which any skilled person must necessarily have become cognizant of from a study of the Reis apparatus*" (126 U. S. 154). It was even admitted by the plaintiff that Bell found a clue to his telephone in the Reis instrument (126 U. S. 297).

This therefore was a situation where "a person trained and skilled in the making of (telegraphs), by studying and

understanding this prior art, could have duplicated the accomplishment of (Bell)" (Compare R. 470). The evidence supporting the application of the "could have duplicated" test was clear. The test was suggested in equivalent language. If the test had been sound, the Bell patents would have been invalidated. But the Court refused to sanction such a test of invention.

At page 539, 126 U. S., this Court said:

"We come now to consider the alleged anticipation of Philipp Reis. And here it is to be always kept in mind that **the question is, not whether the apparatus devised by Reis to give effect to his theory can be made, with our present knowledge, to transmit speech, but whether Reis had in his time found out the way of using it successfully for that purpose;** not as to the character of the apparatus, but as to the mode of treating the current of electricity on which the apparatus is to act, so as to make that current a medium for receiving the vibrations of air created by the human voice in articulate speech at one place, and in effect delivering them at the ear of a listener in another place. Bell's patent is not alone for the particular apparatus he describes, but for the process that apparatus was designed to bring into use. **His patent would be quite as good if he had actually used Reis's apparatus in developing the process for which it was granted.**"

At page 545, the opinion continued:

"Reis never thought of it, and he failed to transmit speech telegraphically. Bell did, and he succeeded. Under such circumstances it is impossible to hold that what Reis did was an anticipation of the discovery of Bell. To follow Reis is to fail, but to follow Bell is to succeed. The difference between the two is just the difference between failure and success. **If Reis had kept on he might have found out the way to succeed, but he stopped and failed.** Bell took up his work and carried it on to a successful result."

The foregoing direct denunciation by this Court of the "could have duplicated" test of invention fully justifies the issuance of the writ of certiorari. The petitioner has no other opportunity to obtain review of the erroneous decisions of the lower courts for the reason that a resulting conflict of decisions directly affecting the patent is improbable (Pet'n. 21-23).

The opinion of the Circuit Court of Appeals uses language positively indicating that its analysis of the prior art and its evaluation of the Waber patent are based upon the "could have" philosophy of mere possibilities and conjecture. Such phrases as: "As we understand" (R. 467); "It must be assumed" (R. 467); "so we think" (R. 467); the Wallace prior art "does not explain" (R. 467); "substantially, if not precisely" (R. 467); "We see no substantial difference" (R. 468); "While this language is not entirely clear" (R. 469); "we are inclined to agree" (R. 469); "Assuming, as we think we must" (R. 469); "could be constructed" (R. 469); "we are of the view" (R. 469); "At any rate, we think" (R. 470); and "could have duplicated" (R. 470) would not have been used by the Circuit Court of Appeals had there been a teaching of the Waber method by the prior art. Such understandings, assumptions, lack of explanation, lack of preciseness, seeings, unclear language, inclinations, views, thoughts, opinions and possibilities are not evidence. They are insufficient to overcome the normal presumption of validity of letters patent issued after an examination by the patent office.

Waber taught the public how, for the first time, to make a successful puncture sealing inner tube. It is important that there is **no evidence** in this record that anyone else could have done so. Certainly no one did. The Court merely said "we are of the opinion" (R. 470) that someone else

could have duplicated Waber, but it pointed to no supporting evidence.

The petitioner argues that the "could have duplicated" test is unjustified because it is contrary to the patent statutes, construed as the Congress intended (Pet'n. 26-27); that it constitutes judicial legislation by the Circuit Court of Appeals (Pet'n. 27-28); that it is in conflict in principle with the decision of this Court in *O'Reilly et al vs. Morse et al* (1853) 15 How. (56 U. S.) 62, 111 (Pet'n. 24-25); and that it is contrary to the public policy of this country as expressed in the detailed report of the late President Roosevelt's National Patent Planning Commission (Pet'n. 27). These grounds are now strengthened by the opinion in *The Telephone Cases*, 126 U. S. 1.

The respondents argue that the "could have duplicated" test is justified in view of the dissenting opinion of Justice Woodbury in *Hotchkiss et al vs. Greenwood et al* (1850) 11 How. (52 U. S.) 248, 268 (Res. Br. 10). The respondents, however, make no attempt to justify the test on statutory grounds or on public policy. Any argument based upon respondents' construction of the dissenting opinion of Justice Woodbury is in direct conflict with the subsequent opinion of this Court in *The Telephone Cases*, 126 U. S. 1 and should be disregarded.

Further, the "could have duplicated" test could always be proved where interfering patent applications were filed. The fact that two people made the same invention is positive evidence that the invention could have been duplicated by another because it was. If the "could have duplicated" test were sound would Congress not have provided that the filing of two interfering applications should invalidate both applications in lieu of providing for several detailed interference proceedings (U. S. Code, Title 35, Section 52, 63,

and 66) to determine priority among the independent "duplicators"?"

In conclusion, petitioner requests reconsideration by the Court, and the granting of the writ. The practical consequences of a ruling by a court of last resort that the presence or absence of invention is to be determined by the test as to whether someone else "could have duplicated" the claimed invention are manifest. Under this test, what patent can ever stand?

The world would not have been without the electric light bulb had Edison not lived. Sawyer and Mann were very close. They could have duplicated Edison. Under the test of the Circuit Court of Appeals, the patent on the DeForest audion would not have been sustained, for had one studied the art he "could have duplicated" it. Both DeForest and Edison utilized knowledge that others had, but which no one had utilized.

A test of invention that has in it the possibilities of destruction of the patent system should be frowned on here as in *The Telephone Cases*.

The undersigned attorneys hereby certify that this petition for rehearing is presented in good faith and not for delay as is required by Rule 33, Rules of this Court.

Respectfully submitted

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October 16, 1945.

